



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,807	09/24/1999	JOHN R. ECKEL JR.	44660-00001	9931

7590 04/11/2002
J KEVIN GRAY
JENKENS & GILCHRIST P C
1445 ROSS AVENUE
SUITE 3200
DALLAS, TX 752022799

EXAMINER

GARG, YOGESH C

ART UNIT PAPER NUMBER

2165

DATE MAILED: 04/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/405,807

Applicant(s)

ECKEL, JOHN R.

Examiner

Yogesh C Garg

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This is with reference to applicant's amendment and IDS, received on January 15, 2002.

Response to Amendment

2. Claims 1, 18 and 25 have been amended and 34-36 are added. The pending claims are 1-36 and they will be considered for examination.

Information Disclosure Statement

3. The information disclosure statement filed on January 15, 2002 after the mailing-date of First Office Action fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p). It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

4. Applicant's arguments with respect to claims 1-36 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. Claim 26 is objected to because of the following informalities: In the preamble of claim 26, " Claim 20" is to be replaced by " Claim 25". Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Regarding claim 2, , the phrase " represented as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Further art rejections of this claim will be done in light of this rejection.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 1-3, 6-7 and 9 rejected under 35 U.S.C. 102(a) as being clearly anticipated by Traderonline.com (Press release, " Florida Tops Boat Trader ® Online Activity ", PR Newswire, New York; Sep 22, 1998, pages marked 1, 2, copy of listing of various Internet sites of Traderonline.com as published in 1997, pages marked 3,4,5, Press release, " Seattle Tops RV Trader ® Online Activity ", PR Newswire; New York; Sep 25, 1998, pages marked 6, and Press Release, " Auto Trader ® Online Partners with The Nalley Companies Offering Best

Used Vehicle Selection in Atlanta ", PR Newswire; New York; Nov 9, 1998, all extracted from Internet on 04/04/2002), hereinafter referred to as Traderonline..

With regards to claims 1-3, 6-7 and 9, Traderonline teaches a method of receiving a request initiated by a consumer and transmitted over a global communication network to a system, said request having a domain name associated with a plurality of domain names each of which includes a common domain name element, said domain name identifying goods/services without identifying a specific provider thereof; selecting, responsive to the received request, at least one name of at least one provider; and forwarding the selected at least one name of the at least one provider from said system to said consumer, wherein said consumer chooses a provider from the selected at least one provider to communicate therewith (see pages 1,2,3, and 4).

Traderonline discloses that a customer can send a request through Internet with a domain name like autotraderonline.com or Boatraderonline.com where the common domain element is traderonline, subject is boat or auto and the extended domain name com. The subject, boat or auto identifies the goods/services requested. The domain name does not identify the provider. On Page 1, Traderonline discloses that there are twenty Internet sites covering automotive, aircraft.....motorcycle ... general merchandise categories. On receipt of the customer's request the site searches and provides the name of providers on a web page. The sites like autotraderonline.com act as an intermediary between said consumer and provider). Traderonline further discloses presenting customized presentation about goods and services offered by the provider(page 1, "...Boat Trader Online also makes its search capabilities available to individuals who own marine-related websites...."Searchmaker" service a webmaster can download the html code necessary.....Access to the Boat Trader Online database ").

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 8, 10-21, 24-25, 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traderonline in view of Gupta et al. (US PG-PUB NO, 2001/002020242 A1).

With regards to claims 4, 8, 10-17, and 34-35, Traderonline teaches a method as disclosed in claim1. Traderonline further discloses using geographic information (page 7, “...*The vehicles can be searched easily by the consumer, using parameters.....model, price or geographic location...*”) to select the goods/services provider. Traderonline fails to teach storing personal preferences, payment instructions using a card number or predetermined payment arrangement , privacy and anonymity instructions, demographic information and using these informations in selecting a provider and also tracking and awarding rewards and tracking ranking of customer’s satisfaction level.

However, Gupta in the field of electronic commerce i.e. targeted advertising, discloses teach storing personal preferences, payment instructions using a card number or predetermined payment arrangement , privacy and anonymity instructions, demographic information and using these informations in selecting a provider and also tracking and awarding rewards and tracking ranking of customer’s satisfaction level (abstract, “*ISP collect and store information regarding particular users...demographic information,....credit history,profile information,*

para 0053, "...supplying the user's name, address, and other relevant information (...credit card number for payment, credit rating, etc.)...", para 055, "...when a user views a web page or completes any transactions on the internet, each and every action is processed.....Additionally, due to the Off-line business relationship between the user and the ISP, privacy concerns may be addressed.").

In view of Gupta, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine the features of storing personal preferences, payment instructions using a card number or predetermined payment arrangement, privacy and anonymity instructions, demographic information and using these informations in selecting a provider and also tracking and awarding rewards and tracking ranking of customer's satisfaction level. Doing so would help the system in customizing information displayed to a consumer as suggested by Gupta (abstract, "*Thus the profile and demographic information can be utilized.....displayed to a client* ").

With regards to claims 18-21, 24-25, 28-33 and 36, Traderonline teaches a system and a method comprising a server for receiving a request from a consumer, transmitted over a global communication network, said request including a domain name associated with a plurality of domain names each of which includes a common domain name element, said server further including a name linking module for selecting, responsive to the received request at least one name of at least one provider; and a controller for forwarding the selected at least one name of the at least one provider to said consumer, wherein said consumer chooses a provider from the selected at least one provider to communicate therewith (see pages 1,2,3, and 4).

Traderonline discloses that a customer can send a request through Internet with a domain name like autotraderonline.com or Boattraderonline.com where the common domain

Art Unit: 2165

element is traderonline, subject is boat or auto and the extended domain name com. The subject, boat or auto identifies the goods/services requested. The domain name does not identify the provider. On Page 1, Traderonline discloses that there are twenty Internet sites covering automotive, aircraft.....motorcycle ... general merchandise categories. On receipt of the customer's request the site searches and provides the name of providers on a web page. The sites like autotraderonline.com act as an intermediary between said consumer and provider). Traderonline further discloses presenting customized presentation about goods and services offered by the provider(page 1, *"..Boat Trader Online also makes its search capabilities available to individuals who own marine-related websites...."Searchmaker" service a webmaster can download the html code necessary.....Access to the Boat Trader Online database "*). Traderonline further discloses using geographic information (page 7, *"...The vehicles can be searched easily by the consumer, using parameters.....model, price or geographic location..."*) to select the goods/services provider. Traderonline information also teaches that the subject matter information is maintained by the system in a database accessible by all domains of the system (page 1, *" Boat Trader Online.....Through its " Searchmaker" service a webmaster.....Boat Trader Online database.....Trader Online.....All can be accessed through www.traderonline.com..."*).

Traderonline fails to teach storing information including demographic information about a consumer in a database. However, Gupta in the field of electronic commerce i.e. targeted advertising, discloses teach storing personal preferences, payment instructions using a card number or predetermined payment arrangement, privacy and anonymity instructions, demographic information and using these informations in selecting a provider and also tracking and awarding rewards and tracking ranking of customer's satisfaction level (abstract, *"/ISP collect and store information regarding particular users...demographic information,....credit*

history,profile information, para 0053, "...supplying the user's name, address, and other relevant information (...credit card number for payment, credit rating, etc.)...", para 055, "...when a user views a web page or completes any transactions on the internet, each and every action is processed.....Additionaly, due to the Off-line business relationship between the user and the ISP, privacy concerns may be addressed.").

In view of Gupta, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine the features of storing personal preferences, payment instructions using a card number or predetermined payment arrangement, privacy and anonymity instructions, demographic information and using these informations in selecting a provider and also tracking and awarding rewards and tracking ranking of customer's satisfaction level. Doing so would help the system in customizing information displayed to a consumer as suggested by Gupta (abstract, *"Thus the profile and demographic information can be utilizeddisplayed to a client "*).

12. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Traderonline in view of Turner, Rob ("The price is right ", Money; New York; May 1999, extracted from Internet on 04/04/2002).

With regards to claim 5, Traderonline teaches a method as disclosed in claim1. Traderonline fails to teach the step of providing comparative pricing and availability about goods and services offered by the provider. However, in the same field of selling on the Internet, Turner discloses the step of providing comparative pricing and availability about goods and services offered by the provider (page 1, last paragraph *"...Fortunately, you can ame the Internet do the work for you.....many new price comparison Websites....."*). In view of

Art Unit: 2165

Turner, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine the features of Turner with Traderonline. Doing so would help customers to find great deals and bargains on the Internet as suggested by Turner (page 1, “*..unearth bargains.....With Thousands of Websites.....there are more ways than ever to find great deals.....*”) and save money.

13. Claims 22-23 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Traderonline and Gupta and further in view of Turner.

With regards to claims 22-23 and 26-27, Traderonline and Gupta teaches a system and a method as disclosed in claims 18 and 25 respectively. Traderonline and Gupta further discloses storing consumer information including privacy and payment instructions in a database within said intermediary system as analyzed in claims 8-15 above. Traderonline and Gupta fails to teach evaluating goods and services using the criteria of price comparison. However, in the same field of selling on the Internet, Turner discloses the step of providing comparative pricing and availability about goods and services offered by the provider (page 1, last paragraph “*...Fortunately, you can ame the Internet do the work for you.....many new price comparison Websites.....*”). In view of Turner, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to combine the features of Turner with Traderonline and Gupta. Doing so would help customers to find great deals and bargains on the Internet as suggested by Turner (page 1, “*..unearth bargains.....With Thousands of Websites.....there are more ways than ever to find great deals.....*”) and save money.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,009,459 to Belfiore et al. discloses "a method for automatically initiating a search for a resource such as a web site when a user has specified (entered) text that is not a valid identifier for the resource, e.g., a uniform resource locator (URL). A heuristic analysis is employed to determine when text entered by the user is presented in the format of a valid identifier such as a URL. When the entered text is determined to not have a valid URL format, the text may be placed in a template to identify/determine the meaning of the entered text " (col.2, lines 12-21. Also see col.4, lines 30-40 and col.6, lines 30-48).

(ii) US Patent 6,341,306 to Rosenschein et al. discloses a "method for retrieving information, including designating at least one word appearing in a display of a body of text generated by a first computer. Responsive to the designation, the at least one designated word is automatically transmitted via a network to a second computer. Data relating to the at least one designated word are received from the second computer " (abstract).

(iii) US Patent 6,151,624 to Teare et al. discloses an " invention generally relates to data processing, and to methods and computer systems for managing names of network resources and locating the resources " (col.1, lines 5-8).

(iv) US Patent 6,085,242 to Chandra discloses "An apparatus and method for implementing a personalized uniform Resource Locator (URL) for a network user is disclosed. The personalized URL apparatus and method comprises the steps of: 1) assigning a unique user identifier associated with the user information, and 2) creating a personalized URL using at least a portion of the unique user identifier prepended to a domain name.

(v) US PG-PUB No: 2002/0004754 to Gardenswartz et al. discloses a method, system and computer program product to store information relating to the consumers' offline behavior purchasing patterns, other relevant information including demographics of the consumer and using this information to deliver targeted advertisements to the consumer, without disclosing the consumer's identifications (paras: 0014, 0019, 0038, 0040, 0044-0049, 0055, 0070 and 0088-0089).

(vi) EP 0848339 A1 to Tetsua, Kozo discloses creating and providing a user with a document containing multiple www resources at the same time (pg.3, lines 35-40).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Yogesh C Garg
Examiner
Art Unit 2165

YCG
April 7, 2002



WYNN COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100